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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	24

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

- ☐ THE PERIOD FOR RESPONSE:
- a) ☐ is extended to run \_\_\_\_\_ or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.
- Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 8/19/97 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing of an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_  
Claims objected to: \_\_\_\_\_  
Claims rejected: \_\_\_\_\_

However;

- ☒ Applicant's response has overcome the following rejection(s): New matter rejection § 132, objection to lack of antecedent basis in specification.
4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because double patenting rejections maintained for reasons of word further, truncation is obvious, applicants are claiming broad range of species.
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☒ Other New declaration is acknowledged.  
See Attached.  
3/105 filed 2/26/97 has been considered + does not affect pending claims.

*Lorraine M. Spector*  
LORRAINE M. SPECTOR  
PATENT EXAMINER

**Attachment to Advisory Action, Paper Number 24**

Regarding the issue of the Information Disclosure Statement:

Applicants originally submitted a four page IDS on 2/15/95. In the Office Action dated 5/30/96, paper number 11, the Examiner notified applicants as follows:

5           The information disclosure statement (PTOL-1449) submitted 2/15/95 has been considered. The Examiner did not find numerous of the documents in application 08/252628 (wherein applicants indicated such documents would be found), and therefore could not consider such. Applicants are invited, in response to this Office Action, to submit copies of any of the non-considered references. Such will be considered to have been submitted with the original information disclosure statement, and therefore need not be accompanied by an additional form 1449, fee or statement. Such submissions will be considered timely only if filed with the response to this, and no subsequent, Office Action.

15           Applicants response to this invitation was to submit a fourteen page form PTO-1449 with the paper filed 11/29/96, to which the Examiner responded, in paper number 21, mailed 2/14/97:

20           Applicants have submitted an extensive, 14 page PTO-1449 with their response. In the previous Office Action, applicants were invited to submit copies of reference which had properly been cited, but of which copies were unavailable. Of the references on the instant PTO-1449, only citations B1, B4, B6, B8-B10, B13, B21, C13, C23, C27, C28, C30, C32, C34-C37, C42, C44, C45, C48, C49, C53, C55, C58, C72, C76, C84, C85, C87, C101, C114, C117, C120, C131, C136, C143, C146, C151, C152, C153, C156-C160, C165, C177, C185, C196, C236 and C237 meet this criterion. Of those, copies of reference C32 (Francis et al.) and C177 (Fisher et al.) were not submitted, therefore these references have not been considered. The remainder of the listed references have either already been made of record, or alternatively are not in compliance with the provisions of MPEP 609, and have therefore not been considered.

30           Thus, any references that were cited on the PTO-1449 filed 11/29/96 which were not submitted with the original IDS filed 2/15/95 are considered not to be in compliance with MPEP 609. Applicants reference to parent application 08/252,628 as a source of copies of such references is not relevant to this issue. All references present in the parent files have been duly considered in the prosecution of this application. However, MPEP 609 clearly states:

“...the examiner will consider information cited or submitted to the Office in a parent application when examining a continuation or continuation - in - part application (See MPEP § 2001.06(b)) which is not a file wrapper continuing application, and a list of the information need not be

Serial Number 08/347780  
Art Unit 1812

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submitted in the continuing application unless applicant desires the information to be printed on the patent."

As applicants have not complied with the requirements of MPEP 609 with respect to the information disclosure statement filed 11/29/96, such will not be considered, i.e. the Examiner will not sign the PTO-1449 submitted therewith, for any reference not originally cited in the PTO-1449 submitted 2/15/95.

The Examiner further notes that no copies of any references were received with the amendment after final rejection, paper number 23, filed 8/19/97.

**Advisory Information:**

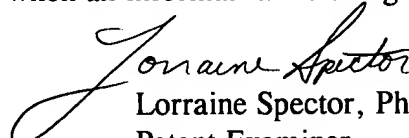
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 8:00 A.M. to 4:30 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Stephen Walsh, can be reached at (703)308-2957.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to (703) 305-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Please advise the Examiner at the telephone number above when an informal fax is being transmitted.

  
Lorraine Spector, Ph.D.  
Patent Examiner

LMS  
347780.adv  
10/8/97